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*ID*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/244,984    02/04/99    BLACK    R    16761/153

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HM22/0607

EXAMINER

OGIHARA, N

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

06/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/244,984

Applicant(s)

BLACK ET AL.

Examiner

Nancy Ogihara

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-62 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to a composition comprising a crystalline form of a TNF- $\alpha$  converting enzyme polypeptide, classified in class 530, subclass 350.
- II. Claims 22-25, drawn to a computer readable medium storing crystallographic coordinate data, classified in class 345, subclass 521.
- III. Claims 26-33, drawn to a system for studying TNF- $\alpha$  converting enzyme polypeptide, classified in class 345, subclass 501.
- IV. Claims 34-39, drawn to video memory storing for visually displaying a TNF- $\alpha$  converting enzyme polypeptide, classified in class 463, subclass 43.
- V. Claims 40-62, drawn to a method of identifying a compound that associates with TNF- $\alpha$  converting enzyme polypeptide, classified in class 514, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions (I and V) and (II-IV) are separate and distinct because the inventions are directed to distinct and unrelated entities regarding the critical limitations therein. For Groups I and V (claims 1-21 and 40-62), the critical feature is composition comprising a polypeptide. In Groups II-IV (claims 22-39) the critical feature is a computer system or components thereof. Groups I and V are biochemical entities with biological and chemical functions and activities, whereas the computer system and components of Groups II-IV are not biological at all. The completely separate classification types and divergent search areas of the inventions of Groups (I and V) and (II-IV) support the undue search burden if not restricted, or if any of the groups were examined together.

Inventions I (claims 1-21) and V (claims 40-62) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the method of identifying a compound that associates with TNF- $\alpha$  can be done using high through put screening of a drug library.

Inventions II (claims 22-25) and III (claims 26-33) are separate and distinct because the computer-readable medium of Invention II does not encompass the system of Invention III which comprises a processor, display, and additional electronic components necessary to operate the system. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Inventions II (claims 22-25) and IV (claims 34-39) are separate and distinct because the computer-readable medium of Invention II is a different electronic component than the video memory of Group IV, and each is made from different materials for different purposes using different modes of function. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Inventions III (claims 34-39) and IV (claims 34-39) are separate and distinct because the video memory of Group IV does not encompass the system of Invention III which comprises a processor, display, and additional electronic components necessary to operate the system. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Ogihara whose telephone number is (703) 308-9363. The examiner can be reached


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Monday-Friday from 8:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Michael Woodward can be reached at (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1631 by facsimile transmission. Papers should be faxed to Group 1631 via the PTO Fax Center located in Crystal Park I. The faxing of such papers must conform with the notice published in the Official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.

Nancy Ogihara  
June 6, 2000

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER